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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 07/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,147

Applicant(s)

GILLESPIE, KEVIN H.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. Claims 1-15, 17-21, 25, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 26 the phrase "sufficient depth so that..." is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. Also, it is noted that there is no guidance in the specification as to what depth is considered to be "sufficient".

Claim 25 depends from claim 24 which has been canceled. It is not clear what claim applicant intends claim 25 to depend from.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pavone (6009637).

Pavone shows a shoe outsole (53 and 55) having an aperture extending from the upper surface to the lower surface in the heel section (shown in figure 3) and a cut-out portion in the sidewall (shown at 22 in figure 1) and a resilient flexible cushion (50) which during use would inherently bulge outwardly and downwardly through both the aperture and cut-out and therefore the cushion is considered to be "shaped to protrude

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through the cut-out portion" inasmuch as applicant has positively claimed and recited such.

4. Claims 1, 4, 5, 6, 11, 12, 15, 17, and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fuerst (4897936).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 11, 15, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preston (5287638) in view of Fuerst.

Preston shows a shoe with an aperture (21) and cushion (24) in the heel of an outsole and a recess in the lower surface of the outsole (figure 3) substantially as claimed except for the exact depth of the recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a "sufficient depth" so that the insert (52) does not engage the walking surface during normal play, which is considered to at least cover "walking" as claimed (see column 1 line 65 – column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Preston to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

In reference to claims 2 and 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use rubber and thermoplastic

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resins, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Claims 1 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duclos (4724624) in view of Fuerst.

Duclos shows a shoe comprising an outsole with a grid pattern and loop (figure 2) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to provide an aperture, recess, and cushion as taught by Fuerst in the shoe of Duclos to increase cushioning and shock absorption.

8. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parisotto (5768806) in view of Fuerst.

Parisotto shows a shoe comprising an outsole with a grid pattern on the top surface of the outsole (figure 1) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to provide an aperture, recess, and cushion as taught by Fuerst in the shoe of Parisotto to increase cushioning and shock absorption.

9. Claims 1, 5, 6, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyer (5325611) in view of Fuerst.

Dyer shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a "sufficient depth" so that the insert (52) does not engage the walking surface during normal play, which is considered to at least cover "walking" as claimed (see column 1 line 65 – column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Dyer to increase cushioning and to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

10. Claims 1, 3, 4, 12, 15, and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone (6009637) in view of Fuerst.

Pavone shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a "sufficient depth" so that the insert (52) does not engage the walking surface during normal play, which is considered to at least cover "walking" as claimed (see column 1 line 65 – column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Pavone to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

Response to Arguments

11. Applicant's arguments with respect to claims 1-15, 17-23, 25, and 26 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed 6/6/02 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Pavone, the cushion of Pavone is inherently "shaped" to protrude into the cut-out in the sidewall of the sole due to the flexible nature of the material the cushion insert. The cushion insert of Pavone would clearly bulge when weighted and the bulge would be forced into all of the openings/cut-outs in the outsole.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's

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convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728